

SN 09/995,304
Docket No. S-94,769
In Response to Office Action dated December 1, 2005

REMARKS

Applicants appreciate the courtesy shown by the Office, as evidenced by the Office Action mailed on December 1, 2005. In that Office Action, the Examiner objected to Claims 15 and 16 and rejected Claims 1-7 and 9-14. Claims 17-63 have been canceled, without prejudice. As such, Claims 1-16 remain in the case with none of the claims being allowed.

The September 14 Office Action has been carefully considered. After such consideration, Claim 1 has been amended, Claims 17-63 have been canceled, without prejudice, and a Request for Continuing Examination (RCE) is submitted herewith. Applicants respectfully request reconsideration of the Application in light of the accompanying amendment and remarks presented herein.

Claims 1-7 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Miltenyi (U.S. Patent 5,543,289).

Applicants submit that independent Claim 1 has been amended to recite the limitations that the magnetic microspheres pass through a magnetic field to a chamber and a collector in which magnetic microspheres having different magnetic moments are separated in the presence of a second magnetic field according to their respective magnetic moments. Support for the amendment is found, for example, in Figure 1 and on page 11, line 18, through page 12, line 6, of the instant Application.

Applicants submit that, in order to anticipate under §102, a reference must teach every element of the claimed invention. Accordingly, Applicants submit that Miltenyi does not teach all of the elements of amended Claim 1.

Applicants submit that Miltenyi does not teach passing magnetic microspheres through a magnetic field to a chamber and a collector in which the magnetic microspheres are separated in the presence of a second magnetic field. Instead, in Figure 1 and column 10, lines 38-47, Miltenyi teaches the introduction of particles into a chamber 11 disposed "between the poles of a magnet 12 (i.e., within a magnetic field)" and filled with a field-intensifying matrix 13 that collects the magnetized particles. The magnetic particles are retained on matrix 13 within the chamber 11 (and, therefore, within the magnetic field), and do not pass through the magnetic field. As the reference states in column 10, lines 45-47: "When the magnetic field is applied, the [magnetic]

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gradient is created and suitably magnetically labeled samples are *retained in the chamber* (emphasis added)."

On page 7 of the December 1 Office Action, the Examiner states that, because Miltenyi teaches that the magnetic microspheres are eventually eluted from the chamber, it is inherent that the magnetic particles are passed through a chamber and a collector. Applicants submit that the reference does not teach that the magnetic microspheres pass thorough a chamber and a collector in which the magnetic microspheres are separated in the presence of a second magnetic field.

Applicants further submit that Miltenyi does not teach the separation of magnetic microspheres having different magnetic moments in the collector. The reference instead teaches that the separation of magnetic materials such as cells, proteins, polysaccharides, and other biological material from non-magnetic materials. See column 4, lines 14-37. Rather than having different magnetic moments, the magnetic materials described by Miltenyi have uniform compositions with homogenous magnetizations. See the Abstract of the reference.

Applicants therefore submit that, because the reference does not teach all of the limitations of amended Claim 1, the rejection of the claim and those claims dependent thereon under 35 U.S.C. §102(b) as being anticipated by Miltenyi is therefore successfully overcome.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miltenyi in view of McDevitt et al. (U.S. Patent 6,649,403).

In order to establish a *prima facie* case of obviousness, the combination of references must either teach or suggest all of the limitations of the claimed invention. Applicants submit that, as previously presented herein, Miltenyi does not teach passing magnetic microspheres through a magnetic field to a chamber and a collector in which magnetic microspheres having different magnetic moments are separated in the presence of a second magnetic field according to their respective magnetic moments. Applicants submit that McDevitt et al. as well does not teach this limitation. Therefore, the rejection of Claim 8 under 35 U.S.C. 103(a) as being unpatentable over Miltenyi in view of McDevitt et al. is successfully overcome.

In light of the amendments and remarks presented herein, Applicants submit that the case is in condition for immediate allowance and respectfully requests such action.

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If, however, any outstanding issues remain unresolved, the Examiner is invited to telephone the Applicants' counsel at the number provided below.

Respectfully submitted,

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